

### **REMARKS**

This communication responds to the Office Action mailed on March 16, 2006. No claims are amended, no claims are canceled, and no claims are added. As a result, claims 1-28 are now pending in this Application.

#### **§112 Rejection of the Claims**

Claim 11 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office notes that “it is not clear how the first receiver operates on a first frequency band wherein the first frequency band forms a subset of a second frequency band that is utilized by the second receiver. ... For examination on the merits, the claims will be interpreted as best understood; the first and second frequency bands will be treated as different frequency bands.” In response, the Applicant respectfully notes that no *prima facie* case of indefiniteness has been established, and therefore, the Applicant respectfully traverses this rejection.

To make out a *prima facie* case of indefiniteness, three elements must be shown: interpretation of the claim in light of the specification; interpretation of the claim as one of ordinary skill in the art would interpret it; and that the limitations in the claim, or the subject matter not in the claim, does not reasonably define the invention. It is noted that “[in] relation to Section 112, second paragraph, the Examiner has the burden of showing that the proposed claim language is indefinite to one of skill in the art.” *See* Patent Prosecution: Practice and Procedure Before the U.S. Patent Office by Irah H. Donner, pg. 831, 2002. This type of showing has not been made.

The Application states:

“...the regular network receiver (e.g., see element 372 in FIG. 3) may operate on a first frequency band forming a subset of a second frequency band utilized by the search receiver (e.g., element 360 in FIG. 3).” Application, Para. [0030].

A subset is “a set each of whose elements is an element of an inclusive set”. Webster’s New Collegiate Dictionary, pg. 1152, G. & C. Merriam Company, 1979. It is clear that the first frequency band elements are included in the set of second frequency band elements with respect

to claim 11. Thus, one of ordinary skill in the art would have no difficulty in determining the subject matter which the Applicant regards as the invention, and therefore, the Applicant respectfully declines to amend claim 11. Reconsideration and withdrawal of the rejection of claim 11 under 35 USC § 112, second paragraph, is respectfully requested.

§102 Rejection of the Claims

Claims 1-8, 13-17, 19-22, 24-26 and 28 were rejected under 35 USC § 102(b) as being anticipated by Anderson (U.S. 6,161,013; hereinafter “Anderson”). The Applicant does not admit that Anderson is prior art and reserves the right to swear behind these references at a later date. In addition, because the Applicant asserts that the Office has not shown that Anderson discloses the identical invention as claimed, the Applicant traverses this rejection of the claims.

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim*.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

With respect to claims 1, 6, 15, 20, and 24, the Office asserts that Anderson discloses “downloading ... a demodulation code” or “a module to download a demodulation code”. However, a careful reading of Anderson reveals this assertion to be incorrect.

Anderson teaches downloading “information regarding the identities of neighboring base stations 104 (including spread spectrum code set and frequency information) from the originating base station 405 ... to the user station 102 during traffic mode or otherwise.” *See* Anderson, Col. 15, lines 62-67. However, this is not the same as what is claimed by the Applicant. As noted in the Application:

“... the method 411 may include selecting a modulation and/or demodulation code from a plurality of codes at block 455, and receiving, downloading, and/or

storing the selected modulation and/or demodulation code to modulate/demodulate information, including the second information received from the second network at block 461. This activity may include downloading to the device (perhaps including receiving and storing) a modulation or demodulation code associated with a second protocol. The modulation code may be associated with or complement the demodulation code, such that information modulated using the modulation code may be demodulated into its original form using the associated demodulation code.” Application, para. [0028].

The modulation code claimed by the Applicant is not the same as the spreading codes of Anderson. As noted in IP Television Magazine (attached hereto as Appendix A):

“In this example, a data file is being transferred from a computer to a WLAN card at 2 Mbps. Each bit of the 2 Mbps data is multiplied by a 10 bit spreading code. For each logic bit in (logic 1 or a logic 0), 10 new bits are produced. This results in a new data rate of 20 Mbps. This 20 Mbps signal is provided to a binary shift keying modulator that creates a 20 MHz wide radio signal (1 bit = 1 Hz). This 20 MHz wide radio signal is received and demodulated by a WLAN card to produce the 20 Mbps data signal. This data signal is provided to a correlator that compares the data to the same 10 bit code that was used to spread the original signal. If a majority of the bits correlate (match) to the original signal, the output data signal is produced. ... Modulation is the process of changing the amplitude, frequency, or phase of a radio frequency carrier signal (a carrier) to change with the information signal (such as voice or data). The 802.11 systems use multiple types of digital modulation. The modulation types used in 802.11 systems have transitioned from simple Gaussian Frequency Shift Keying (GFSK) modulation used in the original 802.11 system to Orthogonal Frequency Division Multiplexing (OFDM) used in the 802.11g system.” IP Television Magazine, pg. 44 and FIG. 2, December 2005.

Thus, spreading codes are introduced at the code multiplexer and correlation stages, and not at the modulation/demodulation stages. The processes are separate. *See Id.* at Figure 2.

Indeed, Anderson also differentiates between demodulation and despreading. Among several instances where Anderson notes the difference between the two processes is the following statement: “Synchronization may be accomplished by ... demodulation and despreading using sliding correlators ...”. *See* Anderson, Col. 3, lines 27.

Therefore, since Anderson does not teach the identical invention claimed, it is believed that independent claims 1, 6, 15, 20, and 24 (as well as all claims depending from them) are in condition for allowance. Reconsideration and withdrawal of the rejection of claims 1-8, 13-17, 19-22, 24-26, and 28 under § 102 is respectfully requested.

§103 Rejection of the Claims

Claims 9-12, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Anderson in view of Sagi et al. (U.S. 2004/0264410; hereinafter “Sagi”). Claim 18 was rejected under 35 USC § 103(a) as being unpatentable over Anderson in view of Jagadeesan et al. (U.S. 2005/0059400; hereinafter “Jagadeesan”). First, the Applicant does not admit that Anderson, Sagi, or Jagadeesan are prior art, and reserves the right to swear behind these references in the future. Second, since a *prima facie* case of obviousness has not been established in each case, the Applicant respectfully traverses these rejections.

No proper *prima facie* case of obviousness has been established because (1) combining the references does not teach all of the limitations set forth in the claims, and (2) combining the references provides no reasonable expectation of success. Each of these points will be explained in detail, as follows.

***Combining References Does Not Teach All Limitations:*** First, with respect to independent claims 6, 15, 20, and 24, no combination suggested in the Office Action will render all of the claim limitations. In a prior Office Action, the Office admitted that Jagadeesan fails to disclose “downloading a demodulation code” or “a module to download a demodulation code” as claimed by the Applicant. Anderson, as noted above, has the same deficiency.

Neither has the Office alleged that Sagi includes the missing elements, and no evidence was found by the Applicant to the contrary. Therefore no combination of Anderson, Sagi, and Jagadeesan can provide these claimed elements, and independent claims 6, 15, 20, and 24 are nonobvious. This conclusion applies with even greater force respecting all of the dependent claims since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

***No Reasonable Expectation of Success:*** Modifying Anderson to include the networks and receivers of Sagi, or the pecuniary relationship of Jagadeesan will not provide an operative combination, since neither Sagi nor Jagadeesan teach downloading a demodulation code.

Therefore, since there is no evidence in the record that combining Anderson, Sagi, or Jagadeesan results in apparatus or methods that operate to download demodulation codes, as claimed by the Applicant; and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 6, 15, 20, and 24, or for any of the claims that depend from them. It is therefore respectfully requested that the rejections of claims 9-12, 23, and 27 under 35 U.S.C. § 103 be reconsidered and withdrawn.

**CONCLUSION**

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney, Mark Muller at (210) 308-5677 to facilitate the prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,  
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